

Remarks**Status of the Application**

Claims 1-14 were pending in the application at the time the Office Action was mailed. All were rejected and no claims were allowed. By this amendment claims 1-14 have been canceled, claims 15-36 have been added, and no claims have been amended. Accordingly, new claims 15-36 are presently pending and before the examiner for consideration. The Commissioner is hereby authorized to charge the fee for the additional claims to Deposit Account 50-3110.

Double Patenting

The Office Action provisionally rejected claims 1-14 on the basis of obviousness-type double patenting in view of co-pending application 10/630,351. Although each of the provisionally rejected claims has herewith been canceled and applicant disagrees with the rejection, in order to expedite prosecution and avoid any subsequent such rejection, a terminal disclaimer in compliance with 37 CFR 1.321(c) is submitted herewith. The Commissioner is hereby authorized to charge the terminal disclaimer fee under 37 CFR 1.20(d), as well as any underpayment or credit any overpayment of fees, pertaining to the terminal disclaimer, to Deposit Account 50-3110.

Rejections Under 35 U.S.C. §§102 and 103

In the Office Action, claims 1, 3, 6, and 9 were rejected under 35 U.S.C. 102(a/e) as being anticipated by Bosley (US 6,348,148); claims 4, 7, 11, 12, and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bosley; and claims 2, 5, 8, 10, and 13 were rejected under 35

U.S.C. 103(a) as being unpatentable over the combination of Bosley and Husick (US 5,830,366).

Claims 1-14 have been canceled.

New claims 15-36 are each novel over Bosley as, among other things, Bosley fails to teach: "a first sea-going vessel comprising a hull" (claims 15-36); "a space in which concentrate can be mixed with seawater, an inlet for introducing concentrate into the space, an inlet for introducing seawater into the space, and an outlet for discharging the diluted concentrate from the space" (claims 15-26); a concentrate discharge system for discharging the diluted concentrate from the first sea-going vessel, the concentrate discharge system being installed on the first sea-going vessel in fluid communication with the water desalination system and comprising at least one discharge member positionable in the body of seawater and comprising (a) a conduit through which concentrate can flow from the water desalination system to the body of seawater and (b) an aspirator through which seawater from the body of seawater can be drawn into the discharge member to mix with concentrate in the conduit (claim 27); or the separate limitations specified in claims 16, 17, 19, 20-26, 29-31, and 33-36.

New claims 15-36 are each novel over Husick as, among other things, Husick fails to teach: a system for desalinating water (claims 15-27) or a method for desalinating water (claims 28-36); the production or processing of a concentrate (claims 15-36); "a mixing system for mixing the concentrate with seawater to yield diluted concentrate, the mixing system being installed on the first sea-going vessel in communication with the water desalination system and comprising a space in which concentrate can be mixed with seawater, an inlet for introducing concentrate into the space, an inlet for introducing seawater into the space, and an outlet for discharging the diluted concentrate from the space" (claims 15-26); a concentrate discharge system for discharging the diluted concentrate from the first sea-going vessel, the concentrate

discharge system being installed on the first sea-going vessel in fluid communication with the water desalination system and comprising at least one discharge member positionable in the body of seawater and comprising (a) a conduit through which concentrate can flow from the water desalination system to the body of seawater and (b) an aspirator through which seawater from the body of seawater can be drawn into the discharge member to mix with concentrate in the conduit (claim 27); "removing salt from the seawater" (claims 28-35); or the separate limitations specified in claims 16, 17, 18, 20-26, 29-32, and 34-36.

Each of claims 15-36 is non-obvious over the combination of Bosley and Husick because even if these references were properly combinable for the purposes of 35 U.S.C. §103, they would still not teach all of the limitations of the pending claims (see above). As an example, the Office Action combines the aspirator/jet pump of Husick with the desalination apparatus of Bosley to reject cancelled claims 2, 5, 8, 10, and 13. Such a combination would still not teach, e.g., "a membrane-based water desalination system installed on the first sea-going vessel..." or "a space in which concentrate can be mixed with seawater, an inlet for introducing concentrate into the space, an inlet for introducing seawater into the space, and an outlet for discharging the diluted concentrate from the space...." or "a concentrate discharge system for discharging the diluted concentrate from the first sea-going vessel..."

Bosley describes discharging undiluted concentrate directly into the surrounding body of water, but not mixing concentrate with seawater before discharging diluted concentrate as claimed in claims 15-36 ("a space in which concentrate can be mixed with seawater...a concentrate discharge system for discharging the diluted concentrate from the first sea-going vessel"). One of the advantages of the presently claimed system is the lessened impact of the diluted concentrate upon the environment compared to directly dumping concentrate into the

surrounding water. Bosley, in fact, teaches away from the desirability of diluting concentrate *before* its discharge to mitigate any environmental damage. See Bosley at Col. 4, lns. 11-14 ("The present invention allows an offshore desalinization facility to release its brine into mid-water, where *mixing with the ocean current* is more efficient, with fewer effects upon bottom-dwelling flora and fauna.").

Regarding Husick, this reference does not even mention desalination. Moreover, Husick does not describe a mixing system for mixing concentrate with seawater to yield diluted concentrate or a concentrate discharge system for discharging diluted concentrate. Instead, the aspirator/jet pump of Husick that the Office Action refers to is used to discharge filtered debris such as marine weeds, grasses and marine organisms (see column 1, second paragraph). Thus, even if Bosley and Husick were properly combinable for the purposes of §103, they still would not teach all the limitations of claims 15-36.

Moreover, neither Bosley or Husick contain a suggestion that it should be combined with the other reference. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

Accordingly, withdrawal of these rejections is respectfully requested.

Conclusion


The currently pending claims are supported throughout the specification and are patentable over the prior art. No new matter has been added. This application is now in full condition for allowance, and such action is respectfully requested.

This amendment is accompanied with a terminal disclaimer and a petition for a retroactive one month extension of time. The Commissioner is hereby authorized to charge the required fees for the terminal disclaimer and the petition, as well as to charge any underpayment or credit any overpayment of fees under 37 CFR 1.16 or 1.17 as required by this paper to Deposit Account 50-3110.

The examiner is cordially invited to call the undersigned if clarification is needed on any matter within this response, or if the examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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